

REMARKS/ARGUMENTS

Claims 1-44 are pending. Solely in an effort to advance prosecution, claim 1 is amended for clarity and to encompass potentially infringing subject matter. No new matter has been added. By the amendment, Applicants do not acquiesce to the propriety of any of the Examiner's rejections and do not disclaim any subject matter to which Applicants are entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Further, Applicants reserve the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

Entry of the above amendment is believed to be proper under 37 C.F.R. § 1.116 because the amendment: (a) places the application in condition for allowance; (b) does not raise any new issues requiring further search and/or consideration; (c) does not present any additional claims without canceling a corresponding number of finally rejected claims; and/or (d) places the application in better form for appeal, should an appeal be necessary. Thus, entry is respectfully requested.

It is believed that each of the claims is now in condition for allowance. However, if anything further is required to place the claims in better condition for allowance, then the Examiner is invited to contact the undersigned representative at the telephone number listed below.

Applicants and the undersigned representatives expressly thank Examiner Epps-Smith for the courtesies extended during the personal interview conducted on September 4, 2009. A separate record of the substance of the interview is expressed in the above claim amendment and/or the comments set forth below.

REJECTION UNDER 35 U.S.C. §§ 102 & 103

The Advisory Action maintains the rejection of claims 1, 2, 4, 6, 10, 20-24, 27-32 and 34-44 under 35 U.S.C. § 102(b) as allegedly being anticipated by Schatz et al. (U.S. Patent No. 6,156,511).

The Advisory Action also maintains the rejection of claims 3, 5, 7, 8 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schatz et al. (U.S. Patent No. 6,156,511) in view of Praszquier et al. (*Journal of Bacteriology*, 181(9):2765-2772 (1999)).

Further, the Advisory Action maintains the rejection of claim 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schatz et al. (U.S. Patent No. 6,156,511) in view of Edwards et al. (U.S. Patent No. 5,716,780).

The Advisory Action still maintains the rejection of claim 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schatz et al. (U.S. Patent No. 6,156,511) in view of Szostak et al. (U.S. Patent No. 6,281,344) in further view of Mattheakis et al. (*PNAS*, 91:9022-9026 (1994)).

In response, Applicants respectfully submit that the features of the rejected claims, which have been clarified to specify that the recited DNA constructs are expressed in an acellular environment, are neither disclosed, taught or suggested by Schatz or the applied secondary references, as previously discussed. Thus, reconsideration and withdrawal of the rejections under §§ 102 and 103 are respectfully requested.

CONCLUSION

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), then please contact the undersigned attorney at the telephone number listed below.

Applicants hereby request any extension of time deemed necessary for entry of this submission and any submission filed hereafter in this application or any continuing application(s). Applicants make a Conditional Petition for any relief available to correct any defect in connection with this filing, or any defect remaining in this application after this filing. The Commissioner is authorized to charge any petition fee or any deficiency in fees filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. **14-1140 (please use reference number: WFG-117-533)** or credit any overpayment of fees to such Deposit Account.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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